

U.S. Patent Application No. 09/694,593  
Attorney's Docket No. 99-317 CIP RCE1

### REMARKS

This amendment is responsive to the final Office Action<sup>1</sup> dated January 11, 2005. Claims 1-37 were presented for examination. All claims were rejected. No claims are canceled. Four new claims are added. Thus, claims 1-41 are pending. Independent claims 1, 14, 21, 22, 29, 36 and 37 have been amended. No new matter is added. Support for these amendments and the new claims is found in the application as filed. For example, *see* at least the terminal screen user interfaces in computers 102, 105, 107 in Fig. 1, and input device 210 in Fig. 2 described in the specification page 7, lines 11-14 as including user interfaces. Also, *see* at least Figs. 1 and 2 and the specification, at least page 7, lines 5-10 and 15-21 for disclosure of storage, e.g., ROM 225, proximate the user interface. Also, *see* at least page 11, lines 15-16 for disclosure of storage of the calling party number in ROM 225 which is proximate the user interface. Also, *see* at least page 12, lines 4-11, where the status message is discussed.

In the Office Action, the Examiner applies four references against Applicant's claims, namely: Mattaway et al., U.S. Patent Number 6,275,490 (hereinafter "Mattaway"); Curry et al., U.S. Patent Number 6,275,490 (hereinafter "Curry"); Wiener et al., U.S. Patent Number 6,324,264 (hereinafter "Wiener"); and Mueller et al., U.S. Patent Number 6,052,411 (hereinafter "Mueller").

<sup>1</sup> The final Office Action may contain a number of statements characterizing the cited references and/or the claims which Applicant may not expressly identify herein. Regardless of whether or not any of those statements is identified herein, Applicant does not automatically subscribe to, or acquiesce in, any of those statements.

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Claims 1-6, 8, 13-14, 16, 21-25, 28-29, 31, 36 and 37 are rejected under 35 U.S.C. § 103(a) as being un-patentable over Mattaway in view of Curry.

Claims 11, 19, 26 and 34 are rejected under 35 U.S.C. § 103(a) as being un-patentable over Mattaway in view of Curry as applied to claims 1, 14, 22 and 29, and further in view of Wiener.

Claims 7, 9-10, 15, 17-18, 30, 32-33 are rejected under 35 U.S.C. § 103(a) as being un-patentable over Mattaway in view of Curry and further in view of Mueller.

Claims 12, 20, 27 and 35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mattaway in view of Curry, in further view of Wiener as applied to claims 11, 19, 26, and 34 and further in view of Mueller.

Claims 1-6, 8, 13-14, 16, 21-25, 28-29, 31, 36 and 37 are rejected under 35 U.S.C. § 103(a) as being un-patentable over Mattaway in view of Curry. Applicant respectfully traverses this rejection because this combination does not disclose or suggest all elements of these claims for the following reasons.

Consider amended independent claim 1, for example, which recites a combination of features:

"A method of making a telephone call using an electronic document stored in a computer having a user interface, the method comprising:  
retrieving the electronic document, the electronic document including data representing at least one telephone number;  
selecting a first telephone number from the electronic document by way of the user interface to obtain a selected telephone number;  
signaling, from the computer via a packet-switched network coupled to a first line, a telecommunication system to connect a call between a first telephone associated with the first telephone number and a second telephone associated with a calling party telephone number in response to the selection of the first telephone number, the calling party telephone number being stored in the computer proximate the user interface, the call being connected via the first line; and

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subsequent to attempting the call, using the stored calling party telephone number to connect all calls from the calling party to any telephone number including the selected telephone number.”  
(Emphasis added)

In the Office Action, page 3, it states “Mattaway does not expressly disclose receiving a calling party telephone number; storing the calling party telephone number in memory within the computer to obtain a stored calling party telephone number; and using the stored calling party telephone number to connect all calls from the calling party, subsequent to attempting the call, to any telephone number including the selected telephone number.” and Applicant agrees that Mattaway is deficient in this regard.

The Examiner relies on Curry to make up for these deficiencies of Mattaway, but Curry falls short. To begin with, claim 1 does not recite either a receiving or a storing step. However, even if those steps were recited in amended claim 1, Applicant respectfully disagrees that Curry teaches: “storing the calling party telephone number in memory within the computer to obtain a stored calling party number” as alleged in the Office Action (Emphasis added), because amended claim 1 limits its computer to one “having a user interface”. By contrast, the computer upon which the Examiner is relying in this rejection does not and cannot have a user interface, because “users” cannot be associated with it. The computer in Curry upon which the Office Action relies to store the calling party number in this rejection is the Internet Telephony Server(s) (ITS 72 a, b, c) as shown in Fig. 6 in Curry. For example, the Examiner’s language: “...where, when the ITS, acts like a phone, it uses its stored calling party number in order to set-up a call...” (final Office Action, page 3, Emphasis added) plainly shows that the computer in Curry being relied upon to teach the storing of the calling party number is the ITS server. But, this server is shown as being

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remotely located on the opposite side of central office 41 from where the user (calling/called parties 64 a, b, c) is located. There cannot be any users located at ITS 72, thereby precluding a user interface at ITS 72. Therefore, although Curry may store something in a server (a server is a computer), it does not disclose or suggest storing a calling party telephone number within a computer having a user interface, to which claim 1 is limited. Furthermore, Curry's ITS server 72 is not located near or proximate a user interface which, if one exists in Curry, would be located near a called or calling party 64 who is the "user" (see Fig. 6 in Curry).

As noted, the Examiner admitted that Mattaway does not disclose the "storing" recited in claim 1, and Applicant has shown above that Curry does not disclose it either. To establish a prima facie case of obviousness, all of three basic criteria must be met: first, the prior art references, when combined, must teach or suggest *all* the claim limitations; second there must be a reasonable expectation of success; and finally, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings ( See MPEP § 2143). If any one of these criteria is not met the prima facie case of obviousness is not established. In this instance, the prior art references, when combined, do not teach or suggest all of the claim limitations.

In view of the above, a prima facie case of obviousness under MPEP § 2143 has not been established against claim 1, at least because all of the claim elements of claim 1 have not been disclosed or suggested. For example, the recited "signaling" act has not been disclosed or suggested. That is, the recited "signaling, from the computer via a packet-switched network

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coupled to a first line, a telecommunication system to connect a call between a first telephone associated with the first telephone number and a second telephone associated with a calling party telephone number in response to the selection of the first telephone number, the calling party telephone number being stored in the computer proximate the user interface, the call being connected via the first line", (Emphasis added), is not disclosed or suggested by Mattaway or Curry taken alone or in any combination for the reasons given above.

Furthermore, the other two references that were cited in the Office Action, namely Wiener and Mueller, taken alone or in combination, do not cure the above-noted deficiencies of Mattaway and Curry. In WIENER, the calling party's telephone number is stored in a remotely located database accessible through the Internet and not locally, in a computer having a user interface (e.g., a personal computer). Thus, "...the calling party telephone number being stored in the computer proximate the user interface..." as recited in claim 1, is not disclosed or suggested by WIENER, because WIENER stores the calling party telephone number remotely from the user in a database that doesn't have a user interface. Applicant shows computers 102, 105, 107 with terminal screen user interfaces in Fig. 1, and shows computer 102 as containing input device 210 in its Fig. 2. Input device 210 is described in Applicant's specification on page 7, lines 11-14 as including user interfaces. Computer 102, in Applicant's Fig. 2, also includes ROM 225 proximate the user interfaces in input device 210. ROM 225 is where the calling party telephone number may be stored. See Applicant's specification, page 11, lines 15-16, for example. Applicant respectfully submits that WIENER's remote directory, accessible only via an Internet link and which may store the calling party's telephone number, is not equivalent to a

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user-interfaced computer which contains a storage device (e.g., ROM) that stores the calling party's telephone number proximate the user interface. Applicant thus submits that WIENER teaches away from Applicant's subject matter as recited in the currently amended claims and does not cure this deficiency of MATTAWAY or CURRY. Finally, MUELLER, does not disclose or suggest storing a calling party's telephone number whereby its disclosure is irrelevant in this regard.

The other two requirements for establishing a *prima facie* case of obviousness are moot, and shall not be considered in view of the failure of the references to show all claim elements. It is therefore submitted that the 35 U.S.C. § 103(a) rejection of claim 1 should be withdrawn and the claim allowed.

The other independent claims in this application which have been rejected under 35 U.S.C § 103(a) on the basis of the same Mattaway/Curry combination of references, namely, claims 14, 21, 22, 29, 36 and 37, have all been amended in a manner similar to that of amended claim 1. Accordingly, it is respectfully submitted that the rejection of these independent claims should be withdrawn and the claims allowed for the same reasons given above.

Claims 2-13, 15-20, 23-28, and 30-35 depend from claims 1, 14, 22, and 29 respectively. All of these dependent claims are allowable, at least for reasons based on their dependencies, directly or indirectly, from allowable independent base claims. It is thus respectfully requested that the rejection of these claims be withdrawn and the claims allowed.

New claim 38 is similar to currently amended claim 21, and new claim 40 is similar to currently amended claim 22. New claims 38-41, as well as currently amended claims 4, 5 and 25

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recite features relating to a status message, a description of which was included in this CIP application at the time of its filing (see specification, page 12, lines 4-11). Neither Mattaway, Curry or Mueller disclose or suggest a status message, as far as Applicant can discern. It is further noted that although Wiener does mention a status message in Table I in column 7, Wiener's status message is clearly not the same as the recited status message of Applicant's claim. For example, Wiener's status message is not described as being sent if the calling party does not answer its telephone "within a specified time period" as recited in amended claims 4 and 25, and new claims 38 and 40. Also, Wiener's status message is not described as including the "calling party telephone number, possible reasons for failure of the call, and remedies for the failure" as recited in amended claims 5 and 25, and new claims 39 and 41. Therefore, even though claims 4-5, 25 and 38-41 are urged to be patentable for reasons presented earlier, hereinabove, these claims are also patentable over any or all of these four references taken alone or in any combination for these additional reasons relating to status message.

### CONCLUSION


In view of the foregoing amendments and remarks, all pending claims are urged to be allowable over the cited references. Applicant respectfully requests the Examiner's reconsideration of this application, and the timely allowance of the pending claims. If any questions remain, the Examiner is invited to contact the undersigned at the telephone number listed below. This amendment is being filed as the submission under an RCE.

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To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 07-2347 and please credit any excess fees to such deposit account.

Respectfully submitted,

By: \_\_\_\_\_

  
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